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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL DANELSKI

Appeal 2015-006000
Application 13/673,376
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–3, 5–7, and 9–13. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to a liquid container cap. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. An article comprising a removable cap for a receptacle capable of holding liquids, wherein the removable cap has a mating end that is capable of forming a closure for the receptacle for retaining liquid in the receptacle, the cap having a fluid

> reservoir with a surface, the surface possessing a release mechanism for selectively dispensing liquid from the receptacle through the release mechanism, the release mechanism is a pressure release valve or a mechanical valve affixed in a non-adjustable position relative to the receptacle at an angle of about 10 degrees to about 80 degrees as measured from a horizontal plane of the mating end of the cap to a vertical plane of the cap.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Dubach	US 4,949,883	Aug. 21, 1990
Brankley	US 5,588,548	Dec. 31, 1996

REJECTION

Claims 1–3, 5–7,[1] and 9–13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dubach and Brankley.

OPINION

The Examiner finds that Dubach discloses most of the limitations of claim 1 including a removable cap (2) for a receptacle (T) and a release mechanism (13) at an angle, but that the release mechanism is not at the recited angle nor is the release mechanism a pressure release valve or a mechanical valve. *See* Final Act. 2–3. Nonetheless, the Examiner finds that Brankley discloses a receptacle with a cap and a release mechanism at an angle of from about 0 to about 60 degrees and that the release mechanism is

[1] Claim 8 is cancelled. *See* Br. 11 (filed Nov. 18, 2014); *see also* Final Act. 2 (mailed Apr. 18, 2014). Thus, the Examiner's inclusion of claim 8 in the heading of the rejection is understood to be a typographical error.

a pressure release valve or a mechanical valve. *Id.* at 3. The Examiner concludes that it would have been obvious "to make the angle of the release mechanism of Dubach 60 degrees, as taught by Brankley, so as to reduce the amount of air that a user would draw into their mouths if drinking or sucking the contents from the receptacle," and that it would have been obvious "to have made the release mechanism of Dubach a pressure release valve or a mechanical valve, as taught by Brankley, so that more control over the flow or release of the contents could be exerted by a user." *Id.*

Appellant argues that the Examiner ignores structural features of the invention related to the angle of the release mechanism relative to the cap because Dubach "discloses that the angle of the discharge spout is not important," and because "[t]he angular position of the adjustable bottleneck of Brankley is derived from annular ribs and a flexible channeling tube (Col. 6, line 66 –Col. 7, line 32) that is separate and distinct from the cap of Brankley." Br. 7–8. Appellant asserts that the Examiner has relied on impermissible hindsight because "the Examiner has essentially ignored the teaching of Dubach that clearly indicates that the angle of the discharge spout is not relevant." Br. 8.

The Examiner responds that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Ans. 7 (citing *In re Keller*, 642 F.2d 413 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986)). The Examiner states that Dubach teaches an angled release mechanism, but not that the release mechanism is angled within the claimed range. *Id.* The Examiner states that the reason to angle the release mechanism of Dubach within the claimed range comes directly from Brankley, namely, it "reduces

the amount of air being drawn into a user's mouth. Ans. 8 (citing Brankley, col. 2, ll. 35–50, Abstract).

We agree with the Examiner on these points. Dubach discloses that "[t]he cover surface (10) is inclined [(i.e., angled)] toward the cone axis (K)," but does not disclose an angle or range of angles for the incline. Dubach, col. 2, ll. 37–38. The Examiner relies on Brankley as disclosing that an angle of from about 0 to 60 degrees reduces the amount of air coming from the reservoir. *See* Brankley, Abstract; *see also* Ans. 8. Appellant does not adequately explain why having an angle as taught by Brankley to reduce the amount of air would not be beneficial to Dubach. Although we appreciate that the angle in Brankley is based on an adjustable bottleneck and that Brankley discloses a separate cap, Dubach already discloses a cap having a release mechanism affixed in a non-adjustable position, and the Examiner relies on Dubach for these features and looks to Brankley for teaching that a particular angle is beneficial. *See* Final Act. 2–3. Moreover, because the Examiner's rationale for modifying Dubach, namely, for reducing air from the reservoir, comes from Brankley (*see* Brankley, Abstract), and is not gleaned from Appellant's Specification, we do not find persuasive Appellant's argument that the Examiner has relied on impermissible hindsight. Further, we do not find it pertinent whether *Dubach* indicates that the particular angle is or is not relevant inasmuch as the Examiner finds that *Brankley* provides a motivation for the proposed modification that results in the valve being disposed at an angle relative to the receptacle that falls within the scope of the claim.

Appellant also argues that "the Examiner has not provided any basis for replacing the discharge spout in the primary reference with a mechanical

valve or pressure release valve." Br. 8. Appellant asserts that because the invention of Dubach is a closure cap that can be manufactured as a single piece, the Examiner has failed to identify a reason that "is grounded in the rationale of the references to make not only the combination of Dubach in view of Brankley, but also completely replace critical elements in each reference to come up with the claimed invention." Br. 8. Appellant contends that the Examiner's rationale "is contrary to the teaching of the primary reference and thus made in hindsight of the present application to support the conclusion of obviousness." Br. 8.

The Examiner responds that the rationale "to make the release mechanism of Dubach a pressure release valve or a mechanical valve comes from general knowledge within the art that it is desirable for a user to have additional control over the flow of fluid from a container or release mechanism." Ans. 8. As such, the Examiner states that the rationale "does not include knowledge gleaned only from the applicant's disclosure; therefore the *prima facie* case of obviousness is not based on improper hindsight reasoning." *Id.* The Examiner also states that, although Dubach teaches a single piece manufactured article,

> the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Id. (citing *In re Keller*, 642 F.2d 413 (CCPA 1981)).

We disagree with Appellant's arguments on this point. Dubach's invention is directed to an improvement in a one-piece closure that is made in a mold without using a slide unit. *See* Dubach, col. 1, ll. 20–25. The

critical aspect of Dubach's invention is injection molding with the closure "in an inclined position . . . as shown in FIG. 6." *Id.* at col. 3, ll. 18–22. Appellant does not adequately explain how having an incline (angle) as taught by Brankley would prevent injecting molding as a one-piece closure. Moreover, contrary to Appellant's assertion that the Examiner is using both a separate bottleneck and a valve to replace the spout of Dubach, which is "contrary to the objective of a single piece manufactured article sought by Dubach" (*see* Br. 8), the Examiner proposes to make the substantially cylindrical release mechanism (spout 13) of the closure of Dubach a nipple (pressure release valve) as taught by Brankley. *See* Final Act. 3. A nipple is a cylinder with one end closed except for a small central opening. *See* Brankley, col. 6, ll. 48–52; Figs. 4, 5. Appellant does not adequately explain why such a cylinder could not me made as part of a one-piece closure to replace the cylindrical spout of Dubach, as the Examiner suggests. In any event, even if it were not possible to manufacture a nipple (pressure release valve) as part of a one-piece closure, and multiple pieces were necessary, tradeoffs involved regarding features, costs, manufacturability, or the like, do not necessarily prevent the proposed combination. *See Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) ("The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another."). In this regard, weighing any benefits lost against those gained, we find that the Examiner's reason for modifying Dubach (so that more control over the flow or release of the contents could be exerted by a user), such that the release mechanism is a

pressure release valve or a mechanical valve (Brankley's nipple), is supported by rational underpinnings.

We have considered all of Appellant's arguments for the patentability of claim 1, but the Examiner has the better position. Accordingly, we affirm the Examiner's rejection of claim 1. Appellant relies on the same arguments for the patentability of claims 2, 3, 5–7, and 9–13 (*see* Br. 6–8), and these claims fall with claim 1.

DECISION

The Examiner's rejection of claims 1–3, 5–7, and 9–13 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED